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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/705,442 | 11/10/2003 | Sheila Tipay | 101 | 4604 |
| 43007 | 7590 | 03/18/2005 | EXAMINER | |
| PAUL L. BROWN EMRICH & DITHMAR, LLC 125 SOUTH WACKER DRIVE, SUITE 2080 CHICAGO, IL 60606-4401 | | | GREEN, BRIAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3611 | |

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|-----------------------------------|-------------------------|--|
| | 10/705,442 | TIPAY, SHEILA | |
| | Examiner Brian K. Green | Art Unit 3611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 February 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 6 and 9-17 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5,7 and 8 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10 November 2003 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election of species I. (figures 4-7) in the reply filed on Feb. 7, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 6 and 9-17 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Feb. 7, 2005.

Claim 6 is directed to the non-elected embodiment shown in figures 12 and 13.

Drawings

The drawings are objected to because the figures fail to show numeral "40" as defined in the specification, page 6, line 13. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or

“New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1-5, 7, and 8 are objected to because of the following informalities: In claim 1, line 7, “said predetermined openings” should apparently be “said openings” since there is no antecedent basis for “said predetermined openings”. In claim 4, line 2, and claim 5, lines 2-3, “the same” should apparently be “said actuating member” since there is no antecedent basis for “the same”. In claim 5, line 1, “said linkage is a pair of linkage members” should apparently be “said rotating drive shaft is linked to said actuating member by a pair of linkage members” since there is no antecedent basis for “said linkage”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cocjin (U.S. Patent No. 3,806,399).

Cocjin shows in figures 1-4 an animated tree including a trunk member (2) having a plurality of openings (34) therein, with said openings having an upper engaging surface (the upper end of each opening) and a lower engaging surface (the lower end of each opening); an actuating member (17) positioned within said trunk member and extending

substantially the length thereof, said actuating member being operable between an extended, upward position and a collapsed, downward position; a plurality of flexible tree branches (3,24) extending through said predetermined openings in said trunk member, with said branches having a proximal end anchored to said actuating member and having a distal end extending outwardly from said trunk member through said openings; wherein when said actuating member is in said extended, upward position, said flexible tree branches contact said upper engaging surface of said openings to force said distal ends of said branches to extend downwardly to the collapsed position, and when said actuating member is in said collapsed position said tree branches contact said lower engaging surfaces of said openings to force said distal ends of said branches to move to an extended position to provide a full sized animated tree. In regard to claim 2, Cocjin shows in figure 2 that the actuating member is driven by a motor member (19). In regard to claim 3, Cocjin shows in figure 2 that the output of said motor member is a rotating drive shaft (the rod projecting out from the motor 19 in figure 2). In regard to claim 4, Cocjin shows in figure 2 that the rotating drive shaft is linked to said actuating member to drive the same. In regard to claim 5, Cocjin shows in figure 2 linkage members (20,22) for moving the actuating member up and down.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cocjin (U.S. Patent No. 3,806,399).

Cocjin discloses the applicant's basic inventive concept except for whether the amount of time it takes to move between the extended position and the collapsed position is between 10 seconds and 5 minutes. It would have been an obvious matter of design choice to move the tree between the extended position and the collapsed position in an amount of time between 10 seconds and 5 minutes since the applicant fails to define any advantage to moving the tree between the extended position and the collapsed position and the time used by Cocjin would work equally as well. Further, it would have been obvious to one in the art to modify Cocjin by moving the tree from the extended position to the collapsed position in the time period specified by the applicant since this would create an amusing and eye-catching display, moving it to fast (faster than 8 seconds) would not create a soothing and relaxing type of display and moving it to slow (more than 5 minutes) would make the tree boring and unappealing to watch.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cocjin (U.S. Patent No. 3,806,399) in view of Byrd et al. (U.S. Patent No. 3,900,637).

Cocjin discloses the applicant's basic inventive concept except for placing guide members within the trunk member to retain the actuating member in alignment with the trunk member. Byrd et al. shows in figure 4 guide members (22, see column 3, lines 40-44) for insuring that the actuating member (20) remains parallel to the tubular trunk (14). In view of the teachings of Byrd et al. it would have been obvious to one in the art to modify Cocjin by attaching guide members within the trunk member since this would

insure that the actuating member remains parallel to the tubular trunk during movement of the actuating member as taught to be desirable by Byrd et al., column 3, lines 40-44. Keeping the actuating member parallel to the trunk member would allow the device to work smoother and to operate in a more reliable manner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
March 14, 2005